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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,094	01/16/2002	Jeff Scott Eder		2417
53787	7590	12/04/2007		
ASSET TRUST, INC. 2020 MALTBY ROAD SUITE 7362 BOTHELL, WA 98021			EXAMINER CHENCINSKI, SIEGFRIED E	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 12/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/046,094

Applicant(s)

EDER, JEFF SCOTT

Examiner

Siegfried E. Chencinski

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August & 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/09/07, 9/03/07, 11/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. Applicant has submitted 190 IDS documents for consideration since the examiner's last Office Action. The examiner has not considered these submissions because he is unable to consider this volume of IDS material. Therefore, the examiner requests Applicant's cooperation in this prosecution under MPEP 609.04(a) III, last paragraph, that Applicant submit a "concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) which are helpful to the Office" will be helpful for any ongoing prosecution of this application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 69, 79 and 88 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 09/994,740 (PreGrant Publication 2004/0215551 A1). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 69, 79 and 88 in the application and independent claims 1 and 27 in the copending application are each concerned with a computer-based method for determining the financial market value for the components of a business enterprise, assessing the financial impact of risk and developing options for enhancing the future financial value of management decisions.

4. Claims 69, 79 and 88 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,393,406 and claims 1 and 12 of U.S. Patent No. 6,393,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 in the application and the independent claims in the patents are each concerned with a computer-based method for determining the financial market value for the components of a business enterprise, assessing the financial impact of risk and developing options for enhancing the future financial value of management decisions.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 69-95 are rejected because the claimed invention is directed to non-statutory subject matter. Claims 69, 79 and 88 are not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition. Dependent claims 70-79, 80-87 and 89-95 are rejected because of their dependence on independent claim 1. In other words, claims 69, 79 and 88 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a clearly asserted utility or a well established utility.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

In the instant application, the independent claims fail to produce a useful, concrete or tangible result because the method steps end with the performance of a financial simulation which is left unused and unapplied. In other words, it is merely an esoteric exercise without a practical application.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 69-95 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. Ordinary practitioners would not be able to achieve repeatable results and thus is not concrete. The invention cannot

achieve repeatable results because its implementation requires many subjective judgments and has so many parameters that that results cannot be repeated independently.

7. Claims 69-95 are also rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that no best mode is found in the specification (MPEP 2106. IV.C.2(2)c)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 69-95 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are the steps which would lead an ordinary practitioner of the art to successfully apply the invention to produce a concrete, reproducible quantitative valuation result of a firm. For example, Independent claims 69, 79 and 88 claim program storage devices readable by a computer and a method for integrated performance management, measuring of financial performance and flexible integration for brand risk management without including one or more clear means for showing the ordinary practitioner how to implement the invention.

9. Independent claims 69, 79 and 88 are rejected under 35 U.S.C. 112, second paragraph, because these claims recite the limitation "brand risk management in the preamble and in the first limitation of each claim. There is insufficient antecedent basis for this limitation in these independent claims. Further, the examiner has been unable to find broader descriptions in the specification which reasonably link risk management to brand risk management.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 69-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandretto (US Patent 5,812,988).

Re. Claims 69-95, Sandretto discloses a computer implemented method and apparatus for: (1) inputting economic variables expected to influence future asset values and asset-specific variables; (2) estimating financial statements, future asset values, and tentative asset NPVs using estimated economic variables and estimated asset-specific variables; (3) estimating different financial statements, future asset values and current asset NPVs assuming different estimates of the economic variables that affect asset values; and (4) processes to: (a) equate; or (2) reduce to acceptably small numbers the differences between: (i) the risk measures, terminal values, default premiums, and risk premiums used to determine current values, and (ii) risk measures, terminal values, default premiums, and risk premiums implied by the estimates of economic and firm-specific variables (Abstract). Sandretto's teaching includes a program storage device readable by a computer, tangibly embodying a program of instructions executable by at least one computer to perform the steps of his method (Col. 14, ll. 30-32). Sandretto implicitly discloses a performance management system for a multi business unit organization, including means for integrating narrow performance data from business units in accordance with an organization matrix determining value contributions, creating scenarios, determining elements of value, determining optimization scenarios, and communicating the optimal features mix to the narrow systems implementation. Sandretto teaches risk management in his method in the title, in the abstract and throughout his specification. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that Sandretto's

risk management teachings could be applied to numerous value parameters of an enterprise, including brand risk management, since applicant's claimed invention includes the variables understood by an ordinary practitioner in a large corporation having numerous business units to be used in risk assessed financial valuations and forecasts for such a corporation. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have used Sandretto's disclosures for the purpose of developing an integrated brand risk management systems, methods and a program storage device for a multi-enterprise organization, motivated by a desire to offer an improved method for estimating asset values (Col. 2, ll. 2-65).

Response to Arguments

10. Applicant's arguments received on August 25, 2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is

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(571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

November 29, 2007



NARAYANSWAMY SUBRAMANIAN
PRIMARY EXAMINER